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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/049,363 | 07/16/2002 | Karl Frauhammer | 10191/2234 | 9974 |
| 26646 | 7590 | 02/02/2004 | EXAMINER | |
| KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004 | | | SAETHER, FLEMMING | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3679 | |

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---|--|
| Office Action Summary | Application No. 10/049,363 | Applicant(s) <i>SW</i> FRAUHAMMER ET AL. | |
| | Examiner Flemming Saether | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Drawings

The drawings are objected to because the same reference numerals refer to different features. Specifically, different reference numerals should be used in each embodiment. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sickles (US 2,450,306) in view of Hay (US 3,765,065). Looking at the embodiment of Fig. 5, Sickles discloses a snap ring comprising an annular clip having "two" portion (56) with lugs (60, 54) and flat ends aligned with a center of the ring, a centering ring member (52) and, a web (not labeled) connecting the centering member to an end of one of the limbs. Since the claims are directed to the "snap ring" any reference to the shaft is only an intended use. Hay discloses a snap ring comprising an annular clip (128) formed of two portions each having a radial cross-section which decreases from one end to the other. At the time the invention was made, it would have been obvious

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for one of ordinary skill in the art to form the clip portion of Sickles with decreasing radial cross sections as disclosed in Hay in order to facilitate the flexing of the clip portions. The decreasing cross section of the clip portion would allow for greater flexing at the ends which in turn would make it easier to operate the clip by requiring less force.

Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew (WO 97/12170) in view of Hay. Looking at Figs. 7 and 8, Bartholomew discloses a snap ring comprising a clip having two clip portions (64) at an end of each is a lug (68) having flat opposing sides while at the other end, of the limbs is situated a web (66) connecting the limbs to a centering ring member. Hay discloses a snap ring comprising an annular clip (128) formed of two portions each having a radial cross-section which decreases from one end to the other. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the clip portion of Bartholomew with decreasing radial cross sections as disclosed in Hay in order to facilitate the flexing of the clip portions. The decreasing cross section of the clip portion would allow for greater flexing at the ends which in turn would make it easier to operate the clip by requiring less force.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew as applied to claim 10, 13 and 14 above, and further in view of Engelmann (US 3,442,171). Engelmann discloses the ends of the two limbs having lugs with flat surfaces radially aligned with a center (see Fig. 12 and 14). At the time the invention

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was made, it would have been obvious for one of ordinary skill in the art to make the flat surfaces on the lugs of Bartholomew radially aligned with the center as disclosed in Engelmann since that would allow for the legs to flex more inward for the snap ring to be easily inserted onto a groove.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (APA) in view of Bartholomew and Hay. In the "Background Information" the APA describes a method wherein a snap rings is inserted into a groove to retain a sealing ring but, does not describe the specifics of the snap ring. Modified Bartholomew discloses a snap ring as described above. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to use a snap ring as disclosed in modified Bartholomew in an application as described in the APA since the snap ring in modified Bartholomew would provide for easy installation and removal.

In response to the Remarks

Applicant argues the objection to the drawings is improper because it is the same reference numerals which refer to the same part in the different figures. In response, the examiner disagrees because it is not the same part in the different figures. For example, the clip part (11) shown in Fig. 1 is clearly not the same as the clip part (also 11) shown in Fig. 2. It should be emphasized that it is the parts of the invention which must be the same and the not simply the features.

The remainder of the remarks have been made moot by the amendments which have been addressed in the above rejections and therefore, no further response is believed necessary.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Flemming Saether
Primary Examiner
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